

REMARKS:

Appellants filed an amended Appeal Brief on 5 February 2007 explaining clearly and in detail why the final rejection of Claims 1-11, 13-23, and 25-44 is improper and why the Board should reverse this final rejection. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellants respectfully request the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

Grounds of Rejection to be Reviewed on Appeal

Issue No. 1. Claims 1-11, 13-23, and 25-36 presently stand rejected under 35 U.S.C. § 102(b) over U.S. Patent 4,799,156 to Shavit et al. ("*Shavit*"). Thus, the issue is whether the *Shavit* reference includes sufficient disclosure in order to anticipate the invention as set forth in the claims.

Issue No. 2. Claims 37-44 presently stand rejected under 35 U.S.C. § 103(a) over *Shavit*. Thus, the issue is whether the teachings of the *Shavit* reference disclose or suggest all of the limitations of the claims as necessary for establishing a *prima facie* case of obviousness, and whether the teachings of the *Shavit* reference can properly be considered modifiable so as to establish a *prima facie* case of obviousness.

Appellants Claims are Allowable Over the Cited References

Section 9 of the Examiner's Answer consists entirely of material repeated verbatim from the Final Office Action mailed 23 September 2004.

Section 10 of the Examiner's Answer consists of two sections, which are in response to Appellants arguments, as set forth in Appellants Appeal Brief. The first section of section 10 responds to whether the *Shavit* reference includes sufficient disclosure in order to anticipate the invention as set forth in the claims and the second section of section 10 responds to whether the teachings of the *Shavit* reference disclose or

suggest all of the limitations of the claims as necessary for establishing a *prima facie* case of obviousness, and whether the teachings of the *Shavit* reference can properly be considered modifiable so as to establish a *prima facie* case of obviousness. Below, Appellants specifically address the first and second sections of Section 10 of the Examiner's Answer.

I. Shavit Fails to Anticipate Claims 1-11, 13-23, and 25-36

The Examiner asserts that "Appellant has not taken advantage of the right to be his own lexicographer in the specification in order to give special meaning to the phrase 'participation criteria'." (12 June 2007 Examiner's Answer, Page 9).

However, Appellants respectfully submit that asserting whether the Appellants have asserted "the right to be his own lexicographer" and stating that *Shavit* identically discloses the "participation criteria", as recited in Appellants claims, is a substantially different matter. For example, Appellants respectfully direct the Boards attention to Appellants arguments as set forth in Appellants Appeal Brief:

Appellants maintain that *Shavit* fails to disclose, teach, or suggest a database as recited in claim 1 that contains:

participation criteria for each participant ***specifying one or more types of transactions in which the participant is willing to participate*** in association with the marketplace, each participant being ***pre-qualified to enter into the one or more types of transactions specified*** in the participation criteria for the participant....

(Emphasis added.) In the Advisory Action, the Examiner cites a portion of *Shavit* purportedly disclosing these limitations. The cited portion of *Shavit* discusses how users – including buyers and sellers in variety of service areas – can subscribe to a market management system for access to all services provided by the system, and also extend system access to non-subscribers. The cited portion of *Shavit* recites:

Referring now to FIG. 2, there is shown a generalized block diagram illustrating the organizational relationship between market participants (i.e., system users) and the interactive market management system 50 according to the

invention. Users may include a wide variety of participants in an industry market as well as other service providers and interested users. Users who subscribe to the services of the interactive market management system have all the services of the system available to them while non-subscribers may access the system and communicate with data bases of subscribers who authorize such access. Subscribers may include such market participants as sellers (i.e. distributors 83, suppliers 84), their agents 98 (e.g., manufacturers' representatives), buyers 82, freight service providers 86, financial service providers 96, commercial service providers 88, information service providers 94, and proprietary service providers 90, as shown. The interactive market management system 50 may also be linked to other interactive market management systems 92 in other industries.

(See Advisory Action, Page 2, line 3 citing *Shavit*, column 5, line 67 - column 6, line 18) This cited *Shavit* excerpt simply indicates that users subscribing to the interactive market management system automatically have all the services of the system available to them. There is no mention of any participation criteria indicative of "types of transactions in which [a] participant is willing to participate." Thus, the portion of *Shavit* relied on by the Examiner provides no evidence that *Shavit* discloses, teaches, or suggests a database containing "participation criteria for each participant" that "specifies one or more types of transactions in which the participant is willing to participate," as recited in claim 1.

As provided for in Appellants Appeal Brief on pages 9-10, the above cited portion of Appellants Appeal Brief is directed to the fact that *Shavit* fails to teach, suggest, or even hint at a database containing "participation criteria for each participant" that "specifies one or more types of transactions in which the participant is willing to participate", as recited in Claim 1.

In response to Appellants above cited argument, the Examiner merely states that because the "Appellant has not taken advantage of the right to be his own lexicographer in the specification in order to give **special meaning** to the phrase 'participation criteria' [... the Examiner is giving] this expression [participation criteria] its **broadest meaning** within the **context of the phrase and the entire claim** of which it is a part (MPEP 2106, II C)." (12 June 2007 Examiner's Answer, Page 9). (Emphasis Added).

However, Appellants respectfully point out that Appellants are confused as to why the Examiner purports to establish a “**special meaning**” of the phrase “participation criteria” and in addition, after the Examiner states that the MPEP mandates that the Examiner base a broad meaning “within the **context of the phrase and the entire claim**”, the Examiner bases the Examiner’s meaning of the phrase “participation criteria” on a portion of the specification and not “within the **context of the phrase and the entire claim**”, as necessitated by the MPEP.

In addition, the Examiner asserts that “*Shavit* explicitly teaches that each participant is registered to participate in one or more types of transactions, as provided in a lengthy listing of examples in Col. 6, ll. 9-15.” (12 June 2007 Examiner’s Answer, Page 9). Appellants respectfully disagree. Appellants respectfully direct the Boards attention to the cited portion of *Shavit*:

Subscribers may include such market participants as sellers (i.e. distributors 83, suppliers 84), their agents 98 (e.g., manufacturers’ representatives), buyers 82, freight service providers 86, financial service providers 96, commercial service providers 88, information service providers 94, and proprietary service providers 90, as shown.

In contrast, Appellants claimed invention requires “participation criteria for each participant **specifying one or more types of transactions in which the participant is willing to participate** in association with the marketplace, each participant being **pre-qualified to enter into the one or more types of transactions specified** in the participation criteria for the participant”. As set forth in Appellants claims, the database contains “participation criteria for each participant” that “specifies one or more types of transactions in which the participant is willing to participate”. In addition, the above cited portion of *Shavit* does not teach, suggest, or even hint at any participation criteria indicative of “types of transactions in which [a] participant is willing to participate.” Thus, Appellants claimed database contains and provides “participation criteria for each participant **specifying one or more types of transactions in which the participant is willing to participate** in association with the marketplace, each participant being **pre-qualified to enter into the one or more types of transactions specified** in the

participation criteria for the participant”. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added). Therefore, Appellants respectfully submit that the rejection of Claim 1 is improper under 35 U.S.C. § 102 and the Board should reverse this rejection.

Appellants further respectfully submit that the Examiner asserts that *Shavit* explicitly teaches “monitoring”. (12 June 2007 Examiner’s Answer, Page 9). Appellants respectfully disagree. Appellants respectfully submit that the Examiner has mischaracterized *Shavit*. For example, the Examiner asserts that “*Shavit* teaches that his system, ‘the selected party is checked in an automatic authorization procedure to verify that the user has selected a party recognized by he [sic] system.’” (12 June 2007 Examiner’s Answer, Page 9). However, the issue is not whether *Shavit* discloses “the selected party is checked in an automatic authorization procedure” as asserted by the Examiner. But instead whether *Shavit* discloses a marketplace operable to “monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction”, as recited in Appellants claims.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. (Emphasis Added). Appellants respectfully submit that ***the Examiner has failed to establish a prima facie case of anticipation in Appellants claims under 35 U.S.C. § 102 with respect to Shavit because Shavit fails to identically disclose each and every element of Appellants claimed invention, arranged as they are in Appellants claims.*** Therefore, Appellants respectfully submit that the rejection of Claim 1 is improper under 35 U.S.C. § 102 and the Board should reverse this rejection.

II. Shavit Fails to establish a *prima facie* case of obviousness of Claims 37-44

Appellants respectfully submit that in response to direct the Boards attention to Appellants arguments as set forth in Appellants Appeal Brief:

Appellants respectfully submit that the Examiner appears to have merely modified portions of Shavit, with the benefit of hindsight using Appellants' claims as a blueprint, to reconstruct Appellants' claims...

With respect to the Examiner's proposed modifications to Shavit, the portion of Shavit cited by the Examiner (column 8, lines 5-22) merely disclose that, in the interactive mode, the system disclosed in Shavit may retrieve and modify information on a remote database. (See Column 8, Lines 8-12) The cited portion of Shavit does not include even the slightest reference to pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the pre-qualification of a participant (based on the monitoring) if such modification is determined to be appropriate. Appellants must conclude that the Examiner's proposed modifications to Shavit appear to be merely an attempt to reconstruct Appellants' claims, with the benefit of hindsight using Appellants' claims as a blueprint, and are unsupported by the teachings of Shavit.

Additionally, the Examiner's supposed motivation for modifying Shavit is Shavit's statement of an advantage of its system (i.e. that dramatic new efficiencies can be provided by the configuration of on-line interactive concurrent electronic services). (See Shavit, column 1, lines 61-68) It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to even attempt to modify Shavit to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to actually modify Shavit to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law. This is particularly true in light of the fact that, as Appellants demonstrated above with respect to independent claim 1, Shavit fails to even disclose, teach, or suggest "participation criteria for each participant" wherein "each participant [is] pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the

participant” and a marketplace operable to “monitor activities of the at least one participant in the ongoing transaction to asses whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction” as recited in claim 1, for example.

As provided for in Appellants Appeal Brief on pages 17-18, the above cited portion of Appellants Appeal Brief is directed to the fact that the Examiner’s proposed modifications to *Shavit* appear to be merely an attempt to reconstruct Appellants’ claims, with the benefit of hindsight using Appellants’ claims as a blueprint, and are unsupported by the teachings of *Shavit*.

In response to Appellants above cited argument, the Examiner merely cites *In re McLaughlin* 443 F.2d 1392,1395,170 USPQ 209,212 (CCPA 1971), which states in pertinent parts that a reconstruction based on hindsight reasoning is proper, so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made. However, as provided for in Appellants Appeal Brief and recited above, the Examiner has not produced or offered any evidence to contradict that the Examiner’s proposed modifications to *Shavit* appear to be merely an attempt to reconstruct Appellants’ claims, with the benefit of hindsight using Appellants’ claims as a blueprint, and are unsupported by the teachings of *Shavit*. Nor has the Examiner produced or offered any evidence to contradict that it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to even attempt to modify *Shavit* to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate. Nor has the Examiner produced or offered any evidence to contradict that it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to actually modify *Shavit* to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate.

For at least the reasons set forth herein, Appellants claims are patentable over the cited references. Appellants respectfully submits that the rejection of Appellants claims is improper and the Board should reverse this rejection.

CONCLUSION:

The Appellants have demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Although the Appellants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

13 August 2007
Date

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